

### **REMARKS**

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is timely filed.

Applicants respectfully request that the Examiner reconsider the present application in view of the following remarks.

#### ***Status of the Claims***

Claims 1, 3 and 4 are currently pending in the present application. The Office Action is non-final. No new matter has been added by way of the present amendment. Claim 1 has been amended, without prejudice or disclaimer, to include organoaluminum compounds found at page 37, line 20, to page 39, line 16 of the present specification. Thus, no new matter has been added.

Based upon the above considerations, entry of the present Amendment is respectfully requested.

#### ***Issue Under 35 U.S.C. § 102(b), Anticipation***

Claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by Hasegawa *et al.*, U.S. Patent No. 6,207,774 (hereinafter the “‘774” patent).

The Examiner asserts that in the ‘774 patent, Examples 10 and 11 disclose the copolymerization process of ethylene and hexene in the presence of diphenylmethylenecyclopentadienyl(2,7-dimethylfluorenyl)zirconium dichloride or diphenylmethylenecyclopentadienyl(2,7-di-*t*-butylfluorenyl)zirconium dichloride, with triisobutylaluminum, and *N,N*-dimethylanilinium tetrakis(pentafluorophenyl) borate.

Also, the Examiner asserts that while only the borate cocatalyst is exemplified, the '774 patent expressly discloses aluminate as a functionally equivalent cocatalyst and the aluminates listed in line 14 of col. 5 to line 4 of col. 6 the '774 patent are organoaluminum compounds.

Further, the Examiner asserts that a skilled artisan would immediately envision using the functionally equivalent aluminate cocatalyst to replace the borate cocatalyst to conduct the ethylene copolymerization as shown in the '774 patent Examples 10 and 11 and therefore, the '774 patent anticipates claim 1. Applicants respectfully traverse.

Applicants have amended claim 1, without prejudice or disclaimer, to include organoaluminum compounds which can be found on pages 37-39 of the present specification.

The '774 patent shows in Examples 10 and 11 that the inclusion of an ionizing compound is an essential component of their process. Since the compounds of the presently amended claim 1 are not aluminate compounds as the ionizing compounds of the '774 patent, the '774 patent fails to disclose all elements of the presently amended claim 1. Thus, the '774 patent fails to disclose all claimed features. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited the '774 patent reference cannot be a basis for a rejection under § 102(b). *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In light of the above, the present invention is not anticipated by the '774 patent.

Applicants respectfully request reconsideration and withdrawal of the present rejection.

***Issue Under 35 U.S.C. § 102(e), Anticipation***

Claims 1, 3, and 4 stand rejected under 35 U.S.C. § 102(e) as anticipated by Tohi *et al.*, U.S. Patent Application Publication No. 2006/0161013 (hereinafter "Tohi"). Applicants traverse and submit that Tohi is not proper prior art under § 102(e).

Tohi claims priority to PCT/JP03/01656, which published in Japanese. MPEP 706.02(f)(1), in part, states:

*...in determining the 35 U.S.C. § 102(e) date, if the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:*

*(1) If the international application meets the following three conditions:*

*(a) an international filing date on or after November 29, 2000;*

*(b) designated the United States; and*

*(c) published under PCT Article 21(2) in English,*

*then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. § 102(e).*

*If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for prior art purposes.*

*The reference may be applied under 35 U.S.C. § 102(a) or (b) as of its publication date, or 35 U.S.C. § 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable). MPEP 706.02(f)(1) (emphasis added).*

Since PCT/JP03/01656 did not publish in English, the February 17, 2003 PCT filing date cited by the Examiner cannot serve as a 35 U.S.C. § 102(e) date for the Tohi reference. Of course, PCT/JP03/01656 published as WO04/029062 on April 8, 2004, which could hypothetically qualify as a valid date under 35 U.S.C. § 102(a), however, on October 31, 2007, Applicants submitted a certified English translation of the priority application (JP-2004-105387,

filed March 31, 2004) for the present application. This certified English translation of the priority document with a March 21, 2004 date antedates the April 8, 2004 publication. Applicants therefore respectfully request reconsideration and withdrawal of the present rejection.

In view of the above remarks, Applicants believe the pending application is in condition for allowance.

### **CONCLUSION**

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.


In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters within the present application that need to be resolved, the Examiner is respectfully requested to contact Craig A McRobbie, Reg. No. 42,874, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: **AUG 29 2008**

Respectfully submitted,

By  #47874  
Marc S. Weiner  
Registration No.: 32,181  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicants